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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/553,068

04/20/2000

Christopher Phillips

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5825

25943

7590

12/23/2008

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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/553,068	<b>Applicant(s)</b> PHILLIPS ET AL.	
	<b>Examiner</b> JAGDISH N. PATEL	<b>Art Unit</b> 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-10, 13-15, 18-20, 22-25, 43-45, 48, 50-52 and 61-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10, 13-15, 18-20, 22-25, 43-45, 48, 50-52, and 61-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This communication is in response to amendment filed 10/31/08..

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/08 has been entered.

#### ***Response to Amendment***

3. Amendment to claims 1,43, and 65 is acknowledged. New claims72-80 have been recorded. added. Accordingly, claims 1-4, 7-10, 13-15, 18-20, 22-25, 43-45, 48, 50-52, and 61-80 are pending and under consideration.

#### ***Response to Arguments***

4. Although the applicant's response with respect to prior 35 USC 112(second) rejection has been considered but is not deemed fully persuasive to overcome the

Art Unit: 3693

112(second) rejection. In particular the applicant argues that "having knowledge of the association between the billing data and the web site provides a basis for the billing service to validate the usage of the billing data" (p. 18). However, there is nothing in the claimed invention(s) that suggest how this association is relevant in the validation process.

See further explanation provided below under 112(second) rejection. (See Claim Rejections - 35 USC § 112 below.).

### ***Claim Rejections - 35 USC § 112***

5. Claims 1-4, 7-10, 13-15, 18-20, 22-25, 43-45, 48, 50-52, and 61-80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following exemplary analysis applies to all claims.

As claimed the validity of the usage of the billing data is carried out via notification of the usage of the billing data received at the billing service. as interpreted by the examiner the validation of the billing data addresses the question "was the billing data provided to the user, used with the web site for which the billing service provided the billing data to the user?" or was it used with another website different from the first website?

How does the billing service determine that the billing data was indeed used with the first website?

The claim is silent as to what specific data or information is provided or included in the notification of usage of the billing data that enable the determination by the billing service whether the first billing data was indeed used with the first website (and not any other website or used with a merchant without a website!). In absence of the claim reciting the notification specifying identity (or information related to) of the website or merchant where the billing data was actually used, the determining step is not possible.

This is one deficiency of the claim causing it to be indefinite because there is no specific process stated to achieve the verification that the billing data was used with the intended website.

The second cause of indefiniteness of the claimed invention arises due to the association process recited because associating a billing data with a specific website does not affect the process of usage of the billing data. If the billing data can be used without regard to its association with the specific website (i.e. intended website) said association does not server any purpose in the entire process. The claim specifies that the association is performed by either the billing service or the user who receives it without stating what process leads to association rendering it indefinite since the associating merely establishes some kind of relationship between the website and the billing data but that relationship is not pointed out. For example, an identity of the website may be embedded in the billing data or a list of websites may be marked with a

Art Unit: 3693

desired website to which the user or the billing service wishes to associate the billing data.

Furthermore, if the user associates the billing data with a specific website (without regard to how this is done), how does the billing service receive this information to verify its usage with the website? To this end, the specification on p.12 lines 3-4 discloses that " The correspondence between billing data and business is tracked by the client 100 and/or it is tracked by the billing service 106. " However, no further teaching of this critical feature is enabled.

Furthermore, the claimed invention fails to state what is the outcome of the determining whether the first billing data was used with the first website when it does not restrict the usage in any manner. The user is not restricted the usage of the billing data in any manner whatsoever. The claim fails to specify why such determination is performed or what is the (at least one) outcome of the determination.

In order to expedite the prosecution of the application, the examiner requests that the applicant point out where support is found for the amended portion of the claim.

6. Claims 72-73 are indefinite due to limitation recites as "means plus function". Exemplary claim 23 is discussed. This analysis applies to all claims having "means for .." limitation(s).

Claims 72-73 recite limitations in "means for" construct. The claims are indefinite because the specification fails to define the scope of the means plus

Art Unit: 3693

function or any equivalent of that structure. In the absence of structure disclosed in the specification to perform the function, the claim lack specificity, rendering the claim as a whole invalid indefiniteness.

The specification teaches Fraud Policy System as a part of Merchant System 106 (Figure 1) and described as a general purpose computer (see para [0016]) with no algorithm to perform the function. The CAFC has ruled (**Aristocrat Technologies Australia Pty Ltd. v. International Game Technology**) held that the means plus function language of the claim lacked sufficient disclosed structure under 35 USC 112(6) and therefore was indefinite under 35 USC 112(2).

[Note: Use the following link or search <http://iplaw.bna.com>  
[http://iplaw.bna.com/iplw/5000/split\\_display.adp?fedfid=6912409&vname=ippqcases2&wsn=102&searchid=5431471&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0](http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=6912409&vname=ippqcases2&wsn=102&searchid=5431471&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0)]

### ***Claim Rejections - 35 USC § 112 (first)***

7. Claims 1-4, 7-10, 13-15, 18-20, 22-25, 43-45, 48, 50-52, and 61-80 rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.

association of the billing data by the user with the first website and determining whether the billing data was used with the first website, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

(see further discussion under 112 (second) rejection.

The specification fails to teach specific data communication between the billing service, the user and a business entity where the user used the billing data. Such communication would establish whether the billing data was indeed used with the

Art Unit: 3693

(intended) web site and based upon such determination authorization of the usage of the billing data is granted or disputed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-630PM Mon-Tue and Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/JAGDISH N PATEL/

Primary Examiner, Art Unit 3693



Application/Control Number: 09/553,068  
Art Unit: 3693

Page 8